

REMARKS

I. Status of the Claims

Claims 1, 4-9, and 11-32 are pending. Without prejudice or disclaimer, claims 1, 4, 11, 12, 17, 18, and 30-32 have been amended and claims 2, 3, and 10 have been cancelled.

Support for the amendments can be found in the claims as originally filed. For example, claims 11 and 12 have been amended to correct for dependency and claims 1, 17, 18, and 30-32 have been amended to incorporate subject matter of previously dependent claims. Accordingly, no new matter is added herein.

II. Rejection Under 35 U.S.C. § 103(a): Combination of Sturla et al. and Ashton et al.

The Examiner rejects claims 1-28 and 30-32 under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent Application No. 2001/0051135 A1 to Sturla et al. ("Sturla") in view of U.S. Patent No. 6,350,433 B1 to Ashton et al. ("Ashton") for the reasons set forth at pages 2-5 of the Office Action. Specifically, the Examiner asserts that Sturla teaches an "aerosol device comprising a polyurethane and/or polyurea multiblock polymer in cosmetically acceptable medium" and a mixture of propellants which may include dimethyl ether and fluoro or non-fluoro hydrocarbons. Office Action at 3-4. The Examiner admits that Sturla does not teach the presently claimed combination of dimethyl ether and at least one C₃-C₅ hydrocarbon as propellants, and relies on Ashton to remedy this deficiency. *Id.* at 4.

According to the Examiner, Ashton teaches a hair spray composition comprising carboxylated polyurethanes and a propellant which is a mixture of a dialkylether

(preferably dimethyl ether) and at least one hydrocarbon (preferably C₃-C₅). Office Action at 5; see Ashton at col. 3, line 64 - col. 4, line 2. The Examiner concludes that "it would have been obvious to one of ordinary skill in the art to combine Sturla et al. with Ashton et al. [and] ...one would have been motivated to do so because Sturla et al. teaches that a mixture of propellants may be used for delivering a polyurethane composition...and Ashton et al. teaches a composition that comprises carboxylated polyurethanes for hair fixing." *Id.* at 5. Applicants traverse the rejection, to the extent it applies to the presently amended claims, for at least the following reasons.

In making a rejection under 35 U.S.C. § 103, the Examiner "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. § 2142. In its decision in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007), the Supreme Court confirmed that the "framework for applying the statutory language of §103" was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious:

- (1) the scope and content of the prior art;
- (2) the differences between the prior art and the claims at issue;
- (3) the level of ordinary skill in the art; and
- (4) secondary considerations.

The obviousness or nonobviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. 467; see also *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1730, 82 U.S.P.Q.2d 1385, 1388 (2007).

Indeed, to establish a *prima facie* case of obviousness, the Examiner must:

make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. Knowledge of applicant’s disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences,” conduct the search and evaluate the “subject matter as a whole” of the invention. The tendency to resort to “hindsight” based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

383 U.S. at 17, 148 U.S.P.Q. at 467. “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” MPEP § 2145(8th ed. September 2007 Rev.). Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. MPEP §2143.01(III) (internal citation omitted).

Applicants direct the Examiner to the present specification, where it is explained in paragraph [007] of the present application as published, that there was a problem with “obtaining formulations that can both produce a gentle spray [as defined in paragraph [005]] and comprise dimethyl ether as a propellant gas.” Sturla itself (as FR 2 782 635) is discussed in paragraph [008] as drawn to “aerosol devices comprising dimethyl ether as a propellant and a polycondensate comprising at least one polyurethane and/or polyurea unit as a fixing polymer. **However, these formulations may not allow a gentle spray to be generated.**” (Emphasis added). The present inventors have found that the drawbacks of prior art such as Sturla may be overcome by the combination of the polyurethane (A) and the mixture of propellants (B), which “may allow the production of a gentle spray while at the same time providing at least one of

the" properties listed at paragraph [010] of the published application. However, there is nothing in Sturla that would indicate to one skilled in the art a need to improve upon their disclosed teachings to provide a more gentle spray, nor any indication that a mixture of propellants may allow a more gentle spray to be achieved.

Furthermore, one skilled in the art would not combine the teachings of Ashton with that of Sturla to render the instantly claimed invention obvious. Although Ashton does teach the use of a combination of hydrocarbon and dialkyl ether propellants, Ashton discloses carboxylated polyurethanes as only one possibility for its hair spray resins. There is no guidance to choose these over the many other resins disclosed at columns 2 and 3 and combine them with the hydrocarbon/dialkyl ether propellant to yield the instant application.

Further, the polycondensate disclosed in Sturla is quite different from the polymer that may comprise carboxylic groups as part of a C₁-C₃ hydrocarbon, as disclosed in Ashton. Sturla's polycondensate may comprise polysiloxane groups, that may further comprise polyurethane with unsubstituted or substituted C₁-C₃₀ hydrocarbon chains bearing carboxylic groups and/or sulfonic groups. See Sturla at col. 2, paragraph [036]. Moreover, Ashton teaches hairspray compositions with high water content, i.e. 10-25% of the total composition. See Ashton at col. 6, lines 47-49. As such, autophobic hairspray additives are needed to impart autophobic behavior to the hairspray composition, particularly in combination with dimethyl ether and high water levels. See Ashton at col. 1, lines 40-63. In contrast, the hairspray compositions disclosed in Sturla do not require water and do not disclose autophobic hairspray additives, all of which are required components in Ashton. Looking at both Sturla and Ashton each as a whole,

there is no motivation in either reference that would have led one of ordinary skill to substitute the propellant of Sturla with the specific propellant combination of Ashton, particularly when Ashton's propellant combination is used with a different type of hair spray resin than that used in Sturla.

In view of such obvious differences between the two teachings, there is no motivation for one skilled in the art to combine Sturla and Ashton with any expectation of success. Accordingly, Applicant submits that the rejection of claims 1-28 and 30-32 under § 103 is improper and should be withdrawn.

III. Rejection Under 35 U.S.C. § 103(a): Combination of Sturla et al. and Ashton et al. and Carballada et al.

The Examiner rejects claim 29 under 35 U.S.C. § 103(a) over Sturla and Ashton in view of U.S. Patent No. 6,703,008 to Carballada et al. ("Carballada") for the reasons set forth at pages 5-7 of the Office Action. The Examiner admits that Sturla and Ashton do not teach "panthenol as [an] additional vitamin." *Id.* at 6. Thus, the Examiner looks to Carballada to cure the deficiencies of Sturla and Ashton.

The Examiner contends that "[o]ne would have been motivated to add panthenol because it would provide the hair spray of Sturla et al. with a conditioning agent that would give a better hair feel ." *Id.* at 7. As discussed above, the Examiner has not established a *prima facie* case of obviousness with respect to the combination of Sturla and Ashton. The addition of Carballada to the combination does not remedy these deficiencies. In particular, the Examiner has given no reason for Ashton to be included in this combination and further, vitamins are not disclosed in the hairspray compositions of Ashton. Therefore, with respect to Ashton, this rejection is improper and Applicants respectfully request its withdrawal.

With respect to Sturla, although Sturla generically recites vitamins at page 4, paragraph [0067], these are merely optional ingredients. Indeed, Sturla nowhere teaches or even suggests the desirability that would lead one of skill in the art to specifically include a vitamin, much less the specific vitamin panthenol, into a hairspray composition to give hair a better feel. Moreover, the exemplified composition disclosed in Sturla does not include any vitamin. See page 4, paragraph [0071]. Thus, there is no guidance in Sturla that would lead a person of skill in the art to pick panthenol as a vitamin to render the instantly claimed invention obvious. Such picking and choosing is prohibited. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600, 837 F.2d 1071, 1075 (Fed. Cir. 1988). Accordingly, Applicants submit that the rejection of claim 29 under § 103 is improper and should be withdrawn.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants assert that the claimed invention is not rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

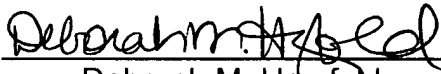
If the Examiner believes a phone call would be useful in resolving the outstanding issues, she is respectfully invited to contact the undersigned at 202-408-4368.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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